

REMARKS

Claims 1-17 are pending in the application.

Claim 17 is amended so that it is now in independent form and so that a typographical error is corrected.

Entry of the Amendment is respectfully requested along with reconsideration and review of the claims on the merits.

Claims 1-17 are rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over Ito et al. (European Patent No. EP 950922 A1) in view of Kondo (U.S. Patent No. 6,080,535), for the reasons given in the Office Action.

The Examiner cites Ito et al. as disclosing a silver halide color photographic material containing a coupler capable of releasing a photographically useful group or its precursor by a coupling reaction between the coupler and a developing agent in an oxidized form. The Examiner asserts that the coupler of the general formula (I-3c) disclosed on page 6 is inclusive of the coupler of Applicants' formulae (I) and (II); also citing exemplified coupler compound 27 and silver halide emulsions disclosed on pages 65-66.

The Examiner cites Kondo as disclosing a silver halide emulsion having enhanced sensitivity without increasing fog, said emulsion comprising tabular silver halide grains wherein at least 50% of the total grain projected area is accounted for by grains having an aspect ratio greater than 5 and containing silver iodide.

The Examiner asserts that it would have been obvious to one of ordinary skill in the requisite art to incorporate the silver halide emulsion taught in Kondo into at least one silver halide emulsion layer of the photographic material of Ito et al.

Applicants respectfully traverse the Examiner's *prima facie* obviousness rejection because the combination of Ito with Kondo fails to render obvious the present invention.

Applicants' Table 3 (see specification, pages 185-187) presents a comparative example in which compound ("ExC-7") and the tabular grain are used in combination. This compound is one covered by the general formula (1-3c) of Ito et al. However, comparative example "ExC-7" is not within the scope of general formulae (I) or (II) of the present invention. As can be clearly understood from the Table, the performance of the comparative example is low when compared to the Examples of the present invention, and the difference is particularly prominent in the interlayer effect. Thus, the present invention can remarkably cause improvement in the interlayer effect, which is not sufficient when the compound of Ito et al. is used in combination with the tabular grain. This improvement in at least the interlayer effect can be achieved by using the compounds covered by the general formulae (I) and (II) of the present invention, which are not disclosed in Ito.

As Applicants explained in the previous Amendment, the present invention is distinguished from the cited references, particularly in terms of the groups $C(R_4)(R_5)INH$ and $(R_3)_m$ bonded to a phenyl group of a phenyloxycarbonylamino in formulae (I) and (II) of the present invention.

Ito et al. does not essentially disclose general formulae (I) and (II) of the present invention, and therefore the present invention recited in Claims 1 to 17 are not *prima facie* obvious over a combination of Ito et al. and Kondo.

More specifically, each of formulae (I) and (II) of the present invention and formula (I-3c) of Ito et al. can be distinguished from each other in terms of the groups $C(R_4)(R_5)INH$ and $(R_3)_m$ bonded to a phenyl group of a phenyloxycarbonylamino in formulae (I) and (II) of the present invention. In the present invention, R_3 is an essential group and it defines a Hammett substituent constant σ_p . In contrast, the exemplified compounds pointed out by the Examiner in Ito, other than compound 27, do not satisfy the conditions for $(R_3)_m$ and/or INH of the present invention. Further, in terms of form, although compound 27 is included in formula (I) of the present invention, Ito et al. does not disclose or even suggest a technical concept that specifies the structure of the compounds expressed by formula (I). Therefore, Applicants submit that it is reasonable to conclude that the structure of compound 27 is only incidentally included in formula (I) of the present invention, and therefore it is not appropriate to conclude that formulae (I) and (II) of the present invention are covered by Ito et al. and disclosed by Ito, merely by the presence of compound 27.

Kondo fails to make up for Ito's deficiencies. Therefore, Applicants submit that the present invention of Claims 1-17 is not rendered obvious from a combination of Ito et al. and Kondo.

Further, Applicants amend Claim 17 from dependent to independent form. Dependent Claim 17 was originally added in the previous amendment, and Claim 17 provides a Markush grouping for the R_3 substituent, which excludes Ito's compound 27. Thus, Claim 17 is also patentable over the combination of Ito et al. with Kondo.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No.: 10/689,356

Atty. Docket No. Q77836

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and earnestly request allowance of Claims 1-17.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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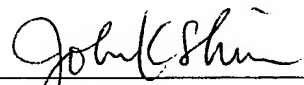
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Date: December 16, 2005